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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,781

10/19/2005

Ekaterina Vladimirovna Barsova

EURE-005

6930

24353 7590 07/15/2009  
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EXAMINER

BERTOGLIO, VALARIE E

ART UNIT

PAPER NUMBER

1632

MAIL DATE

DELIVERY MODE

07/15/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,781	<b>Applicant(s)</b> BARSOVA ET AL.	
	<b>Examiner</b> Valarie Bertoglio	<b>Art Unit</b> 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) 9-11, 14-16 and 19-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13, 17 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/04/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/02/2009 has been entered.

Claims 1-11,13-17 and 19-27 are pending. Claims 9-11,14-16 and 19-26 are withdrawn. Claims 1-8,13,17 and 27 are under consideration.

### ***Claim Objections***

The claims recite non-elected subject matter, specifically, nucleic acids encoding SEQ ID NO:2,6,8,10,12,14,18. Non-elected subject matter must be removed from the claims prior to allowance of the elected invention.

### ***Claim Rejections - 35 USC § 112-1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of claims 1-8,13,17 and 27 under 35 U.S.C. 112, first paragraph, *is maintained* because the specification, while being enabling for an isolated nucleic acid molecule selected from the group consisting of a) a nucleic acid that encodes a protein comprising the amino acid sequence as shown in SEQ ID NOs: 4,18,20,22,24,26, or 28 and cells and vectors comprising said nucleic acid, does not reasonably provide enablement for other claimed embodiments embraced by the breadth of the claims.

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The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The rejection is maintained for reasons of record set forth at pages 3-7 of the office action dated 10/10/2009.

The rejection is on the grounds that the claims encompass variants of a nucleic acid encoding an in active fluorescent protein. One of skill in the art would not know how to use the claimed nucleic acids encoding inactive fluorescent proteins.

Applicant has amended claim 1 to read on an isolate nucleic acid that encodes a fluorescent protein. However, this is not an active functional limitation that requires active fluorescence in the encoded protein. The claims continue to encompass variants that lack fluorescence. The term “fluorescent protein” is a generic name that fits any variant of a fluorescent protein, including variants lacking fluorescent activity. An inactive mutant of GFP, green fluorescent protein, is still referred to as GFP; perhaps it is referred to as ‘mutant’, nonetheless, the name is still “green fluorescent protein”. Thus, an active limitation, such as “wherein the protein encoded by the nucleic acid exhibits fluorescence” is necessary to limit the claim to functional, fluorescing variants. The limitation should be reiterated in claim 13 as 300 residues of any of the nucleic acids falling within the scope of claim 1, wherein the nucleic acid is claim 1 has fluorescent activity, could lack fluorescent activity. Thus, a limitation in claim 1 would fail to limit claim 13.

### ***Conclusion***

**No claim is allowed.**

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valarie Bertoglio whose telephone number is (571) 272-0725. The examiner can normally be reached on Mon-Thurs 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571) 272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Valarie Bertoglio/

Primary Examiner, Art Unit 1632